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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Koichi MASUDA *et al.*
Title: TISSUE ENGINEERED CARTILAGE
FOR DRUG DISCOVERY
Appl. No.: 10/054,710
Filing Date: 01/22/2002
Examiner: Ruth A. Davis
Art Unit: 1645

<p>CERTIFICATE OF MAILING I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on the date below.</p> <p>Robert N. Young (Printed Name)</p> <p><i>[Signature]</i> (Signature)</p> <p>January 16, 2003 (Date of Deposit)</p>

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement set forth in the Office Action mailed December 17, 2002, Applicants hereby provisionally elect Group I, Claims 1-14, 17-30 and 33-35 for examination, with traverse.

The Examiner has required restriction between Claims 1-14, 17-30 and 33-35 (Group I), drawn to a method for determining effects of a test agent, and Claims 15-16 and 31-32 (Group II), drawn to a kit for. Applicants respectfully traverse the restriction requirement.

"If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits[.]" MPEP § 803. Applicant respectfully submits that the Examiner would not be seriously burdened in the search and examination of the few claims of Group II in addition to the search and examination of the elected Group I claims. Although the Office Action stated "the inventions of groups I and II are directed to different inventions which are not connected in design, operation and/or effect" applicants respectfully disagree because the kits described in the claims of Group II

are used in the methods of the claims of Group I. This is evidenced by the fact that the claims of Group II depend from the claims of Group I. Additionally, the Office Action stated that the claims in the groups "have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification)." However, applicants submit that the searches would be related because the groups of claims set forth in the Office Action are both grouped into the same class, class 435. Applicants respectfully submit that the Examiner has not established that a search and examination of claims that fall within the same class but only differ in their subclass designation would be burdensome. Accordingly, applicants respectfully request the Examiner reconsider and withdraw the restriction requirement in the present application.

Applicants believe no fee is due for this submission, however, the Commissioner is hereby authorized to charge any fees due in connection with this submission to Deposit Account No. 50-2350. A duplicate copy of this Response is enclosed for such purposes.

Respectfully submitted,

Date January 16, 2003

By 

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